

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 45

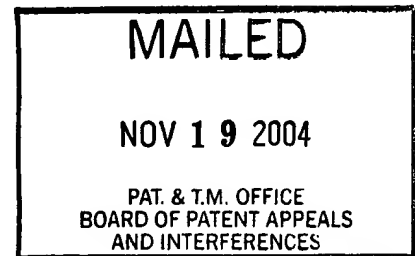
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte AKIRA YOSHIDA

Appeal No. 2004-0560
Application No. 09/040,539

ON BRIEF



Before FLEMING, GROSS, and MACDONALD, **Administrative Patent Judges.**

MACDONALD, **Administrative Patent Judge.**

DECISION ON APPEAL

This is a decision on appeal from the final rejection of claims 1-7 and 9. Claim 8 has been canceled.

Invention

Appellant's invention relates to a computer window display method, device, and control program where a main screen displays a portion of a first page. A first sub-screen displays an image of the entire first page. A second sub-screen displays an image of an entire second page that is sequential to the first page.

The portion of the first page that is displayed on the main screen is also highlighted on the first sub-screen by a rectangle (frame) around the section of the first sub-screen that corresponds to the portion displayed on the main screen. The frame is moveable on the first sub-screen and from the first sub-screen to the second sub-screen. The portion displayed on the main screen changes as the frame is moved so as to correspond to the section of the sub-screen within the frame. Appellant's specification at pages 12-17.

Claim 1 is representative of the claimed invention and is reproduced as follows:

1. A window display device which displays image data on a display screen, comprising:

a first sub-screen displaying a first area of image data;

a main screen displaying a part of said first area of image data with enlargement;

a second sub-screen displaying a second area of image data which is adjacent to said first area of image data;

a first sub-screen image window for displaying an area of image data displayed in said main screen with a display indicating frame on said first sub-screen;

a main screen image window for moving said display indicating frame and said image data within said main screen in correspondence to an output representing movement of a pointing device as notified by said first sub-screen window, said first sub-screen window causing said display indicating frame to be moved within said first sub-screen while said pointing device is in dragging state; and

Appeal No. 2004-0560
Application No. 09/040,539

a second sub-screen image window for displaying said display indicating frame in said second sub-screen when said pointing device has moved said display indicating frame by dragging it into said second sub-screen.

References

The references relied on by the Examiner are as follows:

Middlebrook	5,930,809	Jul. 27, 1999 (filed Sep. 22, 1997)
Tran	6,054,990	Apr. 25, 2000 (filed Jul. 5, 1996)

Rejections At Issue¹

Claims 1-7 and 9 stand rejected under 35 U.S.C. § 103 as being obvious over the combination of Middlebrook and Tran.

Throughout our opinion, we make references to the Appellant's briefs, and to the Examiner's Answer for the respective details thereof.²

OPINION

With full consideration being given to the subject matter on appeal, the Examiner's rejections and the arguments of the Appellant and the Examiner, for the reasons stated *infra*, we reverse the Examiner's rejection of claims 1-7 and 9 under 35 U.S.C. § 103.

¹ The Examiner withdrew all other rejections at issue in the answer. See the answer at page 4, last line.

² Appellant filed an appeal brief on October 7, 2002, fully replacing the brief filed November 5, 2001. Appellant filed a reply brief on May 31, 2002. The Examiner mailed out an Examiner's Answer on March 12, 2002.

Appeal No. 2004-0560
Application No. 09/040,539

Appellant has indicated that for purposes of this appeal, the claims stand or fall together in a single group. See page 4 of the brief. 37 CFR § 1.192 (c)(7) (July 1, 2002) as amended at 62 Fed. Reg. 53169 (October 10, 1997), which was controlling at the time of Appellant's filing of the brief. 37 CFR § 1.192 (c)(7) states:

Grouping of claims. For each ground of rejection which appellant contests and which applies to a group of two or more claims, the Board shall select a single claim from the group and shall decide the appeal as to the ground of rejection on the basis of that claim alone unless a statement is included that the claims of the group do not stand or fall together and, in the argument under paragraph (c)(8) of this section, appellant explains why the claims of the group are believed to be separately patentable. Merely pointing out differences in what the claims cover is not an argument as to why the claims are separately patentable.

We will, thereby, consider Appellant's claims as standing or falling together in a single group, and we will treat claim 1 as the representative claim of that group.

I. Whether the Rejection of Claims 1-7 and 9 Under 35 U.S.C. § 103 is proper?

It is our view, after consideration of the record before us, that the evidence relied upon and the level of skill in the particular art would not have suggested to one of ordinary skill

Appeal No. 2004-0560
Application No. 09/040,539

in the art the invention as set forth in claims 1-7 and 9.

Accordingly, we reverse.

In rejecting claims under 35 U.S.C. § 103, the Examiner bears the initial burden of establishing a **prima facie** case of obviousness. **In re Oetiker**, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). **See also In re Piasecki**, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984). The Examiner can satisfy this burden by showing that some objective teaching in the prior art or knowledge generally available to one of ordinary skill in the art suggests the claimed subject matter. **In re Fine**, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). Only if this initial burden is met does the burden of coming forward with evidence or argument shift to the Appellant. **Oetiker**, 977 F.2d at 1445, 24 USPQ2d at 1444. **See also Piasecki**, 745 F.2d at 1472, 223 USPQ at 788.

An obviousness analysis commences with a review and consideration of all the pertinent evidence and arguments. "In reviewing the [E]xaminer's decision on appeal, the Board must necessarily weigh all of the evidence and argument." **Oetiker**, 977 F.2d at 1445, 24 USPQ2d at 1444. "[T]he Board must not only assure that the requisite findings are made, based on evidence of

Appeal No. 2004-0560
Application No. 09/040,539

record, but must also explain the reasoning by which the findings are deemed to support the agency's conclusion." ***In re Lee***, 277 F.3d 1338, 1344, 61 USPQ2d 1430, 1434 (Fed. Cir. 2002).

With respect to independent claim 1, Appellant argues at pages 20-22 of the brief, "[t]here is no teaching or suggestion to combine Middlebrook and Tran" and "[t]here is no motivation for combining [these] references." We do not find Appellant's arguments persuasive.

In addition to a specific suggestion to combine found in the references, we remind Appellant that the Examiner may find a motivation to combine prior art references in the nature of the problem to be solved. ***Ruiz v. A.B. Chance Co.***, 357 F.3d 1270, 1276, 69 USPQ2d 1686, 1690 (Fed. Cir. 2004); ***Also Pro-Mold & Tool Co. v. Great Lake Plastic Inc.***, 75 F.3d 1568, 1573, 37 USPQ2d 1626, 1630; ***In re Huang***, 100 F.3d 135, 139 n.5; 40 USPQ2d 1685, 1688 n.5 (Fed. Cir. 1996).

Middlebrook teaches that their system shows "a viewer the point in the overall body of text 32 that is currently being displayed." See Middlebrook at column 3, lines 58-60. Tran at column 12, lines 37-38, teaches "displays an outline . . . to indicate the viewing area [to the viewer]," and at lines 60-62, "a zoom box is displayed . . . to indicate to the user his or her

Appeal No. 2004-0560
Application No. 09/040,539

relative position." That is, Tran is directed to solving the problem of showing the viewer the current position in the document being displayed. We find that the nature of the problem to be solved provides more than sufficient motivation to combine the prior art references.

Appellant also argues at page 21 of the brief and pages 2-5 of the reply brief that "[t]he rejected claims specifically recite the additional functionality of the display indicating frame to be dragged from a first sub-screen to a second sub-screen with a pointing device" and "[t]his functionality is not disclosed in either reference."

As pointed out by our reviewing court, we must first determine the scope of claim 1. "[T]he name of the game is the claim." ***In re Hiniker Co.***, 150 F.3d 1362, 1369, 47 USPQ2d 1523, 1529 (Fed. Cir. 1998). Claims will be given their broadest reasonable interpretation consistent with the specification, and limitations appearing in the specification are not to be read into the claims. ***In re Etter***, 756 F.2d 852, 858, 225 USPQ 1, 5 (Fed. Cir. 1985). Our reviewing court also states in ***In re Zletz***, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989) that "claims must be interpreted as broadly as their terms reasonably allow."

As our reviewing court states, "[T]he terms used in the claims bear a 'heavy presumption' that they mean what they say and have the ordinary meaning that would be attributed to those words by persons skilled in the relevant art." **Tex. Digital Sys., Inc. v. Telegenix, Inc.**, 308 F.3d 1193, 1201-02, 64 USPQ2d 1812, 1818 (Fed. Cir. 2002). "Moreover, the intrinsic record also must be examined in every case to determine whether the presumption of ordinary and customary meaning is rebutted." (citation omitted). "Indeed, the intrinsic record may show that the specification uses the words in a manner clearly inconsistent with the ordinary meaning reflected, for example, in a dictionary definition. In such a case, the inconsistent dictionary definition must be rejected." **Tex. Digital Sys., Inc.** 308 F.3d at 1204, 64 USPQ2d at 1819 (Fed. Cir. 2002). ("[A] common meaning, such as one expressed in a relevant dictionary, that flies in the face of the patent disclosure is undeserving of fealty."); **Tex. Digital Sys., Inc.** 308 F.3d at 1204, 64 USPQ2d at 1819 (**citing Liebscher v. Boothroyd**, 258 F.2d 948, 951, 119 USPQ 133, 135 (CCPA 1958). ("Indiscriminate reliance on definitions found in dictionaries can often produce absurd results.")). "In short, the presumption in favor of a dictionary definition will be overcome where the patentee, acting as his or her own

lexicographer, has clearly set forth an explicit definition of the term different from its ordinary meaning." *Id.* at 1204, 64 USPQ2d at 1819. "Further, the presumption also will be rebutted if the inventor has disavowed or disclaimed scope of coverage, by using words or expressions of manifest exclusion or restriction, representing a clear disavowal of claim scope." *Id.* at 1204, 64 USPQ2d at 1819.

If we interpret the term "sub-screen" as the Examiner has done, which is merely as a portion of the screen, then Appellant's argument would be unpersuasive as we find the underlying functionality of the claim and the Middlebrook reference are the same. However, upon our review of the Appellant's specification, we find that the Examiner has not interpreted the claimed "sub-screen" properly. In particular, we find that in the parentheses at page 13, line 4, of the specification, Appellant specifically defines the term "sub-screen" as a "page view sub-window screen." We find that parentheses are used to enclose explanations inserted in the text and the ordinary meaning of "explain" is "to define."³ Thus, we find that Appellant has limited the interpretation of "sub-

³ The Elements of Grammar, 1986, note 3, page 106. The American Heritage Dictionary, Second College Edition, 1982, page 477. Copies provided to Appellant.

Appeal No. 2004-0560
Application No. 09/040,539

screen" to be only a page view sub-window screen. For an example of a page view sub-window screen see page 2 of the "Docuplus" prior art reference cited by Appellant at page 2, line 7, of the specification.

Upon our review of Middlebrook, we find that Middlebrook is not directed to page view sub-window screens but instead is directed to portions of a window. Furthermore, we fail to find any teaching in Middlebrook of page view sub-window screens. Therefore, we do not agree with the Examiner's position that sub-screens are taught by Middlebrook.

We agree with Appellant that the Middlebrook and Tran references fail to teach sub-screens as claimed, and for this reason, fail to teach moving the indicating frame between sub-screens.

Therefore, we will not sustain the Examiner's rejection under 35 U.S.C. § 103.

Other Issues

Should the Examiner deem a rejection to be appropriate based on the Middlebrook patent, the Tran patent, and the Docuplus reference, then we wish to point out patent 5,754,348 to Soohoo. This patent might serve as a replacement for the Tran patent given that it explicitly teaches the benefit at figures 3

Appeal No. 2004-0560
Application No. 09/040,539

and 4 of using a selection frame for "preserving the visual context" (column 1, lines 58-59) of the selected region.

Conclusion

In view of the foregoing discussion, we have not sustained the rejection of claims 1-7 and 9 under 35 U.S.C. § 103.

REVERSED


MICHAEL R. FLEMING
Administrative Patent Judge

Anita Pellman Gross
ANITA PELLMAN GROSS
Administrative Patent Judge

BOARD OF PATENT
APPEALS
AND
INTERFERENCES


ALLEN R. MACDONALD
Administrative Patent Judge

ARM/lbg

Appeal No. 2004-0560
Application No. 09/040,539

INTELLECTUAL BUSINESS MACHINES CORPORATION
IPLAW J46/G467
555 BAILEY AVENUE
SAN JOSE, CA 95141-9989